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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,780	01/21/2005	Tadayoshi Iijima	264857US0PCT	2524

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EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/521,780	Applicant(s) IIJIMA, TADAYOSHI	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/21/05 & 10/12/05</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The use of several trademark only identified compositions found particularly in the specification at page 40, lines 14-21 (as well as in the Examples) for certain species described only as "acrylic resins" and "acrylic monomers" has been noted in this application. They should be capitalized wherever one of them appears and be accompanied by the generic terminology. In particular note that applicant's specification nowhere appears to give a suitable definition or listing of suitable species for each of these genres, both of which are also found in applicant's claims.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, there are a significant number of informalisms and other translation related errors which are present in the claims and need to be corrected; the Examiner will point out as many as possible, but some may be missed and applicant's are also urged to correct these. In claim 1, "further" is informal, as is "type" (the latter being found in many of the claims). The description in many of the claims of a certain layer being "on" another layer is believed in most instances to be unduly vague and indefinite with respect to the element's specific location. The phrases found in claims 7, 8, 11 and 12 which involves "sticking the functional film for

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transfer....through the adhesive layer" which is either "of the film" or "provided beforehand" is not understood. Also, in claims 7,8,11 and 12 it is not clear to the Examiner what element "calcining" is referring to, and in claim 5, line 2, it appears proper to insert -said layer- after "compressing".

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being obvious over either PG Pub 2002/0086138 to Iijima or PG Pub 2002/0037399 to Tamai et al.

The applied references each have a common assignee as well as a common inventor (the '138 reference is also an example of the present inventor's sole efforts) with the instant application. Based upon the earlier effective U.S. filing date of the references, they constitute prior art only under 35 U.S.C. 102(e). These rejections under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in either of the references was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the particular reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the

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same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c).

This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). With respect to the merits of the rejections note particularly the disclosure of the '138 reference, especially paragraph 0154, as well as the Figures, paragraphs 0002, 0005, 0044, 0055, 0082, 0090, 0091, 0110, 0138, the Examples and the claims. With respect to paragraph 0154 of what otherwise appears to be an anticipating disclosure of virtually all of the claimed embodiments and accompanying methods note that the paragraph teaches that the adhesives (of which acrylics and silicones are two of the four cited genres) are "not particularly limited and various known adhesives may be used", which the Examiner believes would definitely put the claimed mixture of at least acrylics (i.e. the "acrylic type monomer" and also (e.g. claim 2) which further can include the "acrylic type resin")) and silicones within the grasp of one of ordinary skill. With respect to the '399 reference the analysis is essentially the same as in the '138 reference, as note particularly paragraph 0086 (which lists both acrylics and silicones, as well as photo-curable adhesives broadly and six additional subgenres of adhesives cited therein). Additionally, note also the Figures and paragraphs 0002, 0003, 0048, 0053-0055, 0059-0064, 0068-0071, 0079-0085, 0087, the Examples and claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also partial machine translations of JP-09-109259, JP-06-

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103839 and JP-08-199096, as well as Iijima '210 (the latter being an earlier effort of the inventor cited by applicant).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Friday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.